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EXAMINER	
GUMBS, KEEGAN ROSS	
ART UNIT	PAPER NUMBER
3751	
MAIL DATE	DELIVERY MODE
10/12/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/706,315	BEDHOME ET AL.	
	Examiner	Art Unit	
	KEEGAN GUMBS	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 14 is objected to because of the following informalities: the examiner believes "said first writing medium reservoir" recited in lines 7-8 of claim 14 should be "said second writing medium reservoir" and is being interpreted that way. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-8, 11-13, 17-23 and 25** are rejected under 35 U.S.C. 102(b) as being anticipated by Keil (US 5,026,189), hereinafter Keil.

Regarding claim 1, Keil discloses a writing instrument having a proximal end and a distal end, said writing instrument comprising:

an inner writing element (48, 49, 44b; refer to Fig. 7) having a first writing tip (49) and a first writing medium reservoir (44b); and

an outer writing element (47, 44a) having a second writing tip (47) and a second writing medium reservoir (44a);

wherein:

an inner axial passage extends through said second writing tip (47) and said second writing medium reservoir (44a);

said inner writing element (49) is positioned in said inner axial passage through said second writing tip and said second writing medium reservoir (see Fig. 7);

said first writing tip is in direct operative contact with said first writing medium reservoir (see col. 4, lines 36-40);

said second writing tip is in direct operative contact with said second writing medium reservoir (see col. 4, lines 54-58); and

said inner writing element and said outer writing element are axially moveable with respect to each other (see col. 4, lines 54-68).

Regarding claim 2, Keil discloses a driving mechanism (46, 46a, 51, 52) operatively coupled to at least one of said first and second writing elements (see col. 4, lines 58-68).

Regarding claim 3, Keil discloses wherein said driving mechanism is proximal end of said writing instrument *(none of claims 1-3 define which end is the proximal end, thus either end can be considered the proximal end).*

Regarding claim 4, Keil discloses said second writing tip is a nib *(the broadest definition of the term "nib" is a point; Fig. 7 clearly shows second writing tip 47 is a point)*.

Regarding claim 5, Keil discloses said nib (47) comprises a connection component (51, 46, 46a) operatively coupling said nib to said second writing medium reservoir (see col. 4, lines 50-65).

Regarding claim 6, Keil discloses said connection component is at least one prong (46a).

Regarding claim 7, Keil discloses said connection component is an open ended cylinder (component 51 is cylinder shaped; see col. 4, lines 54-58 and Fig. 7).

Regarding claim 8, Keil discloses said second writing medium reservoir is a filler-type reservoir (see col. 4, lines 15-19).

Regarding claim 11, Keil discloses said first writing tip is selected from the group consisting of: nib, ball point, roller ball, stylus, chalk, charcoal, and lead. *(The broadest definition of the term "nib" is a point; Fig. 7 clearly shows first writing tip 49 is a point).*

Regarding claim 12, Keil discloses said second writing element is a solid-type writing element (*the second writing element isn't a liquid or a gas thus it must be a solid-type writing instrument).*

Regarding claim 13, Keil discloses said inner writing element has a wall formed from a non-corrosive material. *(Keil discloses the inner and outer writing elements are kept separate by wall 60, thus the wall 60 is at least somewhat non-corrosive to the liquid in the first and second reservoir to some degree).*

Regarding claim 17, Keil discloses a writing instrument having a proximal end and a distal end, said writing instrument comprising:

an outer barrel (42);

a first writing element (47 when concerning claims 18-21; 48, 49 when concerning claim 22) positioned within said outer barrel; and

a second writing element (48, 49 when concerning claims 18-21; 47 when concerning claim 22) positioned within said outer barrel and having a nib-type writing point;

wherein:

said inner and outer writing elements are axially moveable with respect to each other (see col. 4, lines 54-68); and

said outer barrel is configured to permit access to at least one of said inner and outer writing elements (via 46) to remove and to replace said at least one of said inner and outer writing elements.

Regarding claim 18, Keil discloses said outer barrel includes a removable member (46) permitting access to said at least one of said inner and outer writing elements upon removal of said removable member from said outer barrel.

Regarding claim 19, Keil discloses said removable member (46) is a front nose cone (see Fig. 7).

Regarding claim 20, Keil discloses said second writing element (48, 49) has a filler-type writing medium reservoir (44b) (see col. 4, lines 15-19).

Regarding claim 21, Keil discloses a non-porous sleeve (50) covering at least a portion of said writing medium reservoir of said second writing element.

Regarding claim 22, Keil discloses said first writing element (48, 49) extends through an in inner axial passage formed through said second writing element (47).

Regarding claim 23, Keil discloses a filler-type instrument comprising:

an outer barrel (42; see Fig. 7); and

a filler-type reservoir (44b and 48) within said barrel comprising a filler-material saturated with a marking medium (see col. 4, lines 15-22; *portion 48 is clearly a filler-type material since it is shown partially extending into filler-type reservoir 44b in Fig. 7, i.e. 48 is not simply a hollow space. Thus portion 48 is simply an extension of 44b, creating one extended filler-type reservoir)*; and

a writing tip (49) coupled to said filler-type reservoir;

wherein:

said outer barrel includes a removable member (46, 51) permitting access to said filler-type reservoir; and

said filler-type reservoir has a non-porous element (50 and 60) covering at least a portion of said writing tip (separating sleeve 60 covers part of the writing tip and part of the filler-type reservoir portion 48; see Fig. 7) and also covering at least a portion of an outer surface of said filler-type reservoir (both separating sleeve 50 and tube 60 cover at least a portion of the filler-type reservoir 44b and 48 respectively) to permit handling of said filler-type reservoir without being soiled by the marking medium therein; and

said non-porous element acting as a coupling to join said writing tip and said filler-type reservoir together *(separating sleeve 60 joins the writing tip 49 to the filler-type reservoir 48 simply by surrounding both and holding them together. Separating sleeve 60 also joins writing tip 49 to filler-type reservoir 44b; see col. 4, lines 41-45 and Fig. 7).*

Regarding claim 25, Keil discloses said non-porous element (50 and 60) comprises a cartridge case *(elements 50 and 60 themselves cartridge cases).*

4. **Claims 14-16** are rejected under 35 U.S.C. 102(b) as being anticipated by Bolton (WO 02/064379 A1). *(The initial office action disclosed the US patent publication Bolton US 2004/0161282, which is depended on Bolton WO 02/064379 A1, to anticipate the following claims. This was an error and the reference was meant to be Bolton WO 02/064379 A1 which is now recited. Though a different reference is now used the rejection has not been changed since the teachings of Bolton 2004/0161282 which were relied upon in the nonfinal rejection are fully supported in their entirety in Bolton WO 02/064379 A1).*

Regarding claim 14, Bolton discloses a writing instrument having a longitudinal axis, a proximal end, and a distal end, said writing instrument comprising:

an inner writing element having a first writing tip (25; see Fig. 7 and 9) adjacent said distal end of said writing instrument, and a first writing medium reservoir (21; not shown in Fig. 7 but pointed out in prior figures, for example Fig. 6), said first writing medium reservoir having a rear end;

an outer writing element having a second writing tip (43) adjacent said distal end of said writing instrument, and a second writing medium reservoir (8 not shown in Fig. 7 but pointed out in prior figures, for example Fig. 6) said second writing medium reservoir having a rear end; and

a driving mechanism (the screw interaction between 42 and 41; see Fig. 9) operatively coupled to at least one of said inner writing element and said outer writing element;

wherein:

an inner axial passage extends through said second writing tip and said second writing medium reservoir (see Fig. 7);

said inner writing element is positioned in said inner axial passage in said outer writing element;

said inner and outer writing elements are axially moveable with respect to each other (see page 10, the last full paragraph);

said driving mechanism is located at said rear end of at least one of said first or second writing medium reservoirs (see Fig. 7 and 9); and

actuation of said driving mechanism causes axial movement of at least one of said inner and outer writing elements (see page 10, the last full paragraph).

Regarding claim 15, Bolton discloses said driving mechanism comprises a first driving member (42) and a second driving member (41) movably coupled to each other.

Regarding claim 16, Bolton discloses said first driving member is operatively coupled to said inner writing element (see Fig. 7 and 9);

said second driving member is operatively coupled to said outer writing element (see Fig. 7 and 9); and

one of said first and second driving members is coupled to at least a portion of an outer barrel such that movement of said portion of said outer barrel actuates said driving

mechanism to move one of said writing elements axially *(second driving member 41 makes up the back portion of an outer barrel which surrounds the inner and outer writing elements)*.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Keil, as discussed supra.

Regarding claims 9 and 10, Keil fails to disclose the second writing medium reservoir has an oval non-circular cross section. It would be mere matter of design choice to have the second reservoir have a an oval non-circular cross section since the applicant has not disclosed that having the second reservoir have an oval non-circular cross section solves an stated problem an is for any particular purpose and it appears that a second reservoir of any particular shape, including circular, works equally as well.

7. **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Keil, as discussed supra, in view of Sukhna et al. (US 6,561,713 B2).

Regarding claim 24, Keil discloses a non-porous element but fails to disclose what kind of material the non-porous element is. Attention, however, directed to Sukhna which discloses a filler-type reservoir having a polypropylene wrap (see claim 9) in order to hold the reservoir together. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to have modified the non-porous element of Keil to be polypropylene in view of Sukhna. Such a modification would hold the filler-type reservoir of Keil together.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13, 18-20, 23 and 26 of U.S. Patent No. Bedhome et al. (US 7,147,392 B2). Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the patented claims and the present claims are minor and obvious from each other. For example, the differences between claim 1 of the patented invention and claim 1 of the present invention are minor and obvious. Claim 1 of the present invention is a broader version of the patented claim (i.e. claim 1 of the present invention does not include the limitation of an "outer barrel") Therefore, the patented claim 1 would read on the present claim 1 and any infringement over the patented claim 1 would also infringe over the present claim 1.

Response to Arguments

9. Applicant's arguments filed 07/27/2010 have been fully considered but they are not persuasive.

One page 8 of the Remarks section and with respect to claim 1, the Applicant has argued that Keil does not disclose said inner writing element and said outer writing element are axially moveable with respect to each other because the inner writing tip (49) of Keil is stationary and is therefore, not axially moveable. The Applicant has not claimed that the inner writing element and outer writing element are both axially

moveable; the Applicant has claimed the inner writing element and outer writing element are axially moveable with respect to each other. Thus only one of the writing elements is required to be axially moveable. Keil discloses said inner writing element and said outer writing element are moveable with respect to each other. In other words, even though the inner writing element may appear to not move with respect to other elements of the device when the driving mechanism is operated, with respect to the outer writing element the inner writing element is moving axially. A simple way of illustrating this is by driving in a car past a road sign. Even though the road sign is not moving it appears as though it is moving with respect to the driver because the driver is moving with the car past the sign; with respect to the driver the sign appears to move backwards. If the inner writing element and outer writing element of Keil did not move axially with respect to each other, then the inner writing element would never be capable of being exposed. Therefore, Keil discloses said inner writing element and said outer writing element are axially moveable with respect to each other as claimed in claim 1.

One page 9 and 10 of the Remarks section and with respect to claim 23, the Applicant has argued that the non-porous element of Keil does not couple the reservoir to the writing tip in view of the amendments made to claim 23. The new rejection, necessitated by the amendments to claim 23, clearly shows that Keil teaches this limitation (non-porous member 60 clearly couples writing tip 49 to both the filler-type reservoirs 44b and 48).

One page 11 of the Remarks section and with respect to claim 14, the Applicant has argued that Bolton does not disclose said inner writing element and said outer

writing element are axially moveable with respect to each other because the writing tip (43) of Bolton is not axially moveable. The Applicant has not claimed that the inner writing element and outer writing element are both axially moveable; the Applicant has claimed the inner writing element and outer writing element are axially moveable with respect to each other. Thus only one of the writing elements is required to be axially moveable. The very last 2 lines of claim 14 even claim that only at least one of the inner and outer writing elements has to be capable of moving by actuation of the driving mechanism. Bolton discloses said inner writing element and said outer writing element are moveable with respect to each other. In other words, even though the writing element (43) may appear to not move with respect to other elements of the device when the driving mechanism is operated, with respect to the inner writing element the outer writing element is moving axially. A simple way of illustrating this is by driving in a car past a road sign. Even though the road sign is not moving it appears as though it is moving with respect to the driver because the driver is moving with the car past the sign; with respect to the driver the sign appears to move backwards. If the inner writing element and outer writing element of Bolton did not move axially with respect to each other, then the inner writing element would never be capable of being exposed and utilized. Therefore, Bolton discloses said inner writing element and said outer writing element are axially moveable with respect to each other as claimed in claim 14.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEEGAN GUMBS whose telephone number is (571) 270-5608. The examiner can normally be reached on Monday through Friday 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. G./
Examiner, Art Unit 3751
October 7, 2010

/David J. Walczak/
Primary Examiner Art Unit 3751